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Keisuke Horigami

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Fujitsu Patent Center
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EXAMINER

STRODER, CARRIE A

ART UNIT

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12/21/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/786,102	Applicant(s) HORIGAMI ET AL.	
	Examiner CARRIE A. STRODER	Art Unit 3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 6, 8 and 10-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 6, 8, and 10-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is in response to the applicant's communication filed on 06 November 2009, wherein:

Claims 1, 6, 8, and 10-13 are currently pending.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 06 November 2009 has been entered.

Requirement for Information

1. Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

2. Examiner notes that the application has a foreign priority date of 9/29/2003, yet no information resulting from communications with the Japanese patent office has been submitted. Applicant is required to submit any communications from the Japanese patent office, with an English translation,

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which may have bearing upon the patentability of the application.

3. This requirement is an attachment of the enclosed Office action. A complete reply to the enclosed Office action must include a complete reply to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action.

Claim Objections

2. Claims 1, 6, 8, and 10-13 objected to because of the following informalities: the claims use the abbreviation "ID" without defining the abbreviation. Appropriate correction is required.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. **Claim 13 is rejected** under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time

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the application was filed, had possession of the claimed invention. Examiner has reviewed applicant's disclosure and submits that these added limitations find no support in the specification as currently written, and is, therefore, directed to new matter.

a. "wherein the processor determines whether or not that the ID of the target product is valid and cancels decision of authorized registration of the target product by the authorized registration propriety decision section" is not described in the specification as written. Examiner reviewed the specification (no portions were cited) and did not find the limitation as claimed.

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claims 1 and 10-13 are rejected under 35 U.S.C. 112, second paragraph,** as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 states, "a processor that includes, an information acquisition section...an authorized registration propriety decision section...a temporary registration section...a historical

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information storage section...an information updating section..., "which is confusing. A processor is not normally referred to as having "sections", but merely as performing particular functions. For the purposes of the prior art rejections below, Examiner interprets this claim such that the processor is performing the actions claimed.

3. **Claim 13 is rejected under 35 U.S.C. 112, second paragraph,** as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13 states, in pertinent part, "wherein the processor determines whether or not that the ID of the target product is valid, and cancels decision of the propriety of authorized registration of the target product by the authorized registration propriety decision section," which is confusing, since claim 1 states that the registration propriety decision section is part of the processor. Claim 13, therefore, seems to contradict claim 1. Since Examiner is unsure what is meant by claim 13, further examination of the claim is precluded.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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Claims 1 and 10-13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 1 recites, in part, "a processor that includes, an information acquisition section...an authorized registration propriety decision section...a temporary registration section...a historical information storage section...an information updating section..." A "section" may be interpreted as software, rather than structure; therefore, claims 1 and 10-13 are directed to software, per se, which is not patentable subject matter. SEE MPEP 2106.01.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. **Claims 1, 6, 8, and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rogers et al. (US 5978774).**

Referring to claim 1:

Rogers teaches

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a first database that registers product IDs of products (col. 7, lines 49-53; "The valid data is then stored in the manufacturer's national serial number database");

a second database (col. 5, lines 66-67; "...a local database...");

a first memory that stores temporary registration condition information indicating IDs which are specified by at least one of a lot number of a product line for a product and a date of manufacture of a product (col. 5, lines 15-25; "a check may be made to ensure that the serial number is valid" where it is implied that memory contains the condition);

a second memory (col. 5, lines 15-25; "...the overrides should be monitored to ensure the ability is not abused. This may be done, for example, by generating a periodic report listing all overrides by individual managers" implies that memory contains the override monitoring information); and

a processor that includes (col. 4, lines 36-45; "central computer system" includes a processor),

an information acquisition section that acquires product information concerning a target product via a network, the product information including an ID of the target product (col. 3, lines 54-64 and col. 5, lines 15-25; "...the register and the local computer system may communicate, for example, through

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modems and telephone lines..." and "...a check may be made to ensure that the serial number is valid...");

an authorized registration propriety decision section that decides propriety of authorized registration of the target product based on a basis of the product information acquired by the information acquisition section, and registers the ID of the target product in the first database when it is decided that the authorized registration of the target product is proper (col. 7, lines 49-53; "The valid data is then stored in the manufacturer's national serial number database");

a temporary registration section that temporarily registers the ID of the target product in the second database when the target product is decided to be improper for authorized registration by the authorized registration propriety decision section and when the product information concerning said the target product conforms to said the temporary registration conditions condition information (col. 7, lines 38-53; "The decoded serial number information is initially stored in a temporary database..." and "Following validation of the serial numbers, an on-line summary report may be generated which lists all accepted and rejected serial numbers. The valid data is then stored..." implies that the invalid data remains stored only in the temporary database);

a historical information storage section that stores historical information concerning temporary registration processing executed by the temporary registration section in the second memory (col. 7, lines 38-53; "...an on-line summary report may be generated which lists all accepted and rejected serial numbers..."); and

an information updating section that updates said the temporary registration condition information stored in the first memory based on a basis of said the historical information stored in said historical information storage section the second memory and the ID of the target product (col. 7, lines 38-53 and col. 5, lines 15-25; "...the overrides should be monitored to ensure the ability is not abused" implies that the report could be used to disallow certain managers or stores from overriding the system, thereby preventing the temporary registration from taking place).

Furthermore, describing IDs as "specified by at least one of a lot number of a product line for a product and a date of manufacture of a product" is non-functional descriptive data.

When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed nonfunctional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all

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claim limitations when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401,404 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. *See Gulack*, 703 F.2d at 1384-85,217 USPQ at 403; *see also Diamond v. Diehr*, 450 U.S. 175, 191,209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. *See In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is nonfunctional and will not be given any patentable weight. That is, such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate.

The Examiner asserts that whether the IDs are specified by a lot number and date of manufacture can add little, if anything, to the claimed acts or steps and thus does not serve as limitations on the claims to distinguish over the prior art.

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MPEP 2106IV b 1(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with the way the steps are performed". Any differences related merely to the meaning and information conveyed through data, which does not explicitly alter or impact the steps is non-functional descriptive data. The subjective interpretation of the data does not patentably distinguish the claimed invention.

Referring to claim 6:

Rogers teaches

computer instructions that are stored on a computer readable medium and, when executed, cause a computer including a first memory that stores temporary registration condition information indicating IDs which are specified by at least one of a lot number of a product line for a product and a date of manufacture of a product, to perform the following (col. 5, lines 15-25; "a check may be made to ensure that the serial number is valid" where it is implied that memory contains the condition and further, where, "including a first memory that stores temporary registration condition information indicating IDs which are specified by at least one of a lot number of a product line for a product and a date of manufacture of a

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product" receives little patentable weight as it does not further limit a computer readable medium and it is part of the preamble, which also receives little patentable weight, and further, includes non-functional descriptive data (see below)):

acquiring product information concerning a target product via a network, the product information including an ID of the target product (col. 3, lines 54-64 and col. 5, lines 15-25; "...the register and the local computer system may communicate, for example, through modems and telephone lines..." and "...a check may be made to ensure that the serial number is valid...");

deciding propriety of authorized registration of said the target product based on the product information acquired by the acquiring product information, and registering the ID of the target product in a first database when it is decided that the authorized registration of the target product is proper (col. 7, lines 49-53; "The valid data is then stored in the manufacturer's national serial number database");

temporarily registering the ID of the target product in a second database when the target product is decided to be improper for authorized registration by the deciding and registering and when the product information concerning the target product conforms to the temporary registration condition

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information (col. 7, lines 38-53; "The decoded serial number information is initially stored in a temporary database..." and "Following validation of the serial numbers, an on-line summary report may be generated which lists all accepted and rejected serial numbers. The valid data is then stored..." implies that the invalid data remains stored only in the temporary database);

storing historical information concerning temporary registration processing executed by the temporarily registering in a second memory (col. 7, lines 38-53; "...an on-line summary report may be generated which lists all accepted and rejected serial numbers..."); and

updating said the temporary registration condition information stored in the first memory based on the historical information stored in the second memory and the ID of the target product (col. 7, lines 38-53 and col. 5, lines 15-25; "...the overrides should be monitored to ensure the ability is not abused" implies that the report could be used to disallow certain managers or stores from overriding the system, thereby preventing the temporary registration from taking place).

Furthermore, describing IDs as "specified by at least one of a lot number of a product line for a product and a date of manufacture of a product" is non-functional descriptive data.

When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed nonfunctional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401,404 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. *See Gulack*, 703 F.2d at 1384-85, 217 USPQ at 403; *see also Diamond v. Diehr*, 450 U.S. 175, 191, 209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. *See In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is nonfunctional and will not be given any patentable weight. That is, such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate.

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The Examiner asserts that whether the IDs are specified by a lot number and date of manufacture can add little, if anything, to the claimed acts or steps and thus does not serve as limitations on the claims to distinguish over the prior art. MPEP 2106IV b 1(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with the way the steps are performed". Any differences related merely to the meaning and information conveyed through data, which does not explicitly alter or impact the steps is non-functional descriptive data. The subjective interpretation of the data does not patentably distinguish the claimed invention.

Referring to claim 8:

Rogers teaches

a product information registration management method applied to a computer including a first database that registers product IDS of products and a first memory that stores temporary registration condition information indicating IDs which are specified by at least one of a lot number of a product line for a product and a date of manufacture of a product, to perform the following (col. 5, lines 15-25 and col. 7, lines 49-53; "The valid data is then stored in the manufacturer's national serial

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number database" and "a check may be made to ensure that the serial number is valid" where it is implied that memory contains the condition and further, where, "a product information registration management method applied to a computer including a first database that registers product IDS of products and a first memory that stores temporary registration condition information indicating IDs which are specified by at least one of a lot number of a product line for a product and a date of manufacture of a product" receives little patentable weight as it is part of the preamble, which receives little patentable weight, and further, includes non-functional descriptive data (see below)):

acquiring product information concerning a target product via a network, the product information including an ID of the target product (col. 3, lines 54-64 and col. 5, lines 15-25; "...the register and the local computer system may communicate, for example, through modems and telephone lines..." and "...a check may be made to ensure that the serial number is valid...");

deciding propriety of authorized registration of said the target product based on the product information acquired by the acquiring product information, and registering the ID of the target product in a first database when it is decided that the

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authorized registration of the target product is proper (col. 7, lines 49-53; "The valid data is then stored in the manufacturer's national serial number database");

temporarily registering the ID of the target product in a second database when the target product is decided to be improper for authorized registration by the deciding and registering and when the product information concerning the target product conforms to the temporary registration condition information (col. 7, lines 38-53; "The decoded serial number information is initially stored in a temporary database..." and "Following validation of the serial numbers, an on-line summary report may be generated which lists all accepted and rejected serial numbers. The valid data is then stored..." implies that the invalid data remains stored only in the temporary database);

storing historical information concerning temporary registration processing executed by the temporarily registering in a second memory (col. 7, lines 38-53; "...an on-line summary report may be generated which lists all accepted and rejected serial numbers..."); and

updating said the temporary registration condition information stored in the first memory based on the historical information stored in the second memory and the ID of the target

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product (col. 7, lines 38-53 and col. 5, lines 15-25; "...the overrides should be monitored to ensure the ability is not abused" implies that the report could be used to disallow certain managers or stores from overriding the system, thereby preventing the temporary registration from taking place).

Furthermore, describing IDs as "specified by at least one of a lot number of a product line for a product and a date of manufacture of a product" is non-functional descriptive data.

When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed nonfunctional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401,404 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. *See Gulack*, 703 F.2d at 1384-85, 217 USPQ at 403; *see also Diamond v. Diehr*, 450 U.S. 175, 191, 209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. *See In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d

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1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is nonfunctional and will not be given any patentable weight. That is, such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate.

The Examiner asserts that whether the IDs are specified by a lot number and date of manufacture can add little, if anything, to the claimed acts or steps and thus does not serve as limitations on the claims to distinguish over the prior art. MPEP 2106IV b 1(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with the way the steps are performed". Any differences related merely to the meaning and information conveyed through data, which does not explicitly alter or impact the steps is non-functional descriptive data. The subjective interpretation of the data does not patentably distinguish the claimed invention.

Referring to claim 10:

Rogers teaches wherein the temporary registration section deletes the ID of the target product registered in the second database when a predetermined period elapses after the ID of the targeted product is temporarily registered in the second database (col. 7, lines 38-53; "...information is initially stored in a temporary database..." implies that the information is deleted after a predetermined time period).

Referring to claim 11:

Rogers teaches wherein when the authorized registration propriety decision section registers the ID of the target product in the first database within the predetermined period after the ID of the targeted product is temporarily registered in the second database, the historical information storage section stores historical information concerning registration processing executed by the authorized registration propriety decision section in the second memory (col. 7, lines 49-53 and lines 38-53; "The valid data is then stored in the manufacturer's national serial number database" and "...an on-line summary report may be generated which lists all accepted and rejected serial numbers...").

Referring to claim 12:

Examiner asserts that "wherein the information acquisition section acquires the product information concerning the target product when the target product is shipped from a factory" is not a positive claim limitation, as claim 1 is an apparatus claim and when the information is acquired does not further limit the apparatus of claim 1. Further, it would have been obvious to a person having ordinary skill in the art at the time of invention to acquire information when the product is shipped from the factory, as that would allow the information to be accurately entered and verified by the manufacturer, resulting in fewer errors.

Response to Amendment

1. The amendment filed 05 May 2009 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

a. "wherein the processor determines whether or not that the ID of the target product is valid and cancels decision of authorized registration of the target product by the authorized registration propriety decision section".

Applicant is required to cancel the new matter in the reply to this Office Action.

Response to Arguments

2. Applicant's arguments with respect to claims 1, 6, 8, and 10-13 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

a. Rechterman et al. (US 20040199608).

Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CARRIE A. STRODER whose telephone number is (571)270-7119. The examiner can normally be reached on Monday - Thursday 8:00 a.m. - 5:00 p.m. ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jan Mooneyham can be reached on (571)272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CARRIE A. STRODER/
Examiner, Art Unit 3689

/Dennis Ruhl/

Primary Examiner, Art Unit 3689